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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,794	12/05/2001	Kenji Tabata	04995/042001	1844

22511 7590 04/04/2006

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EXAMINER

JELINEK, BRIAN J

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,794

Applicant(s)

TABATA, KENJI

Examiner

Brian Jelinek

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 2-3, and 5 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

The Examiner respectfully submits a response to the amendment received on 1/18/2006 of application no. 10/007,794 filed on 12/5/2001 in which claims 1-5 are currently pending.

Arguments

The Applicant's arguments have been fully considered but they are not persuasive. Please refer to the following office action, which clearly sets forth the reasons for non-persuasiveness.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to provide the CCD back disclosed in Ishiguro is suggested in the background of the

invention "to record electronic information on a record medium, instead of to record an image of a subject on a film" (Ishiguro: col. 1, lines 15-25). As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the CCD back for the film plane disclosed in Fukuda to provide a photographer with increased flexibility by capturing an image on a variety of media.

The Applicant further argues:

Fukuda cannot show or suggest images that are formed within length-direction image pickup effective ranges and breadth-direction image pickup effective ranges set in a solid state image pickup device; and an image pickup effective range change member for changing the length-direction image pickup effective ranges and the breadth-direction image pickup effective ranges *set in the solid state image pickup device*.

In response, Fukuda discloses a square exposure frame (Fig. 7, exposure frame 130) with dimensions equal to the height of an image taken in a portrait orientation and the width of an image taken in landscape orientation (Figs. 8-9), such that the exposure frame may capture images in either the portrait or landscape orientation. Furthermore, Ishiguro discloses providing a CCD imaging plane for a film image plane. However, the combination of Fukuda and Ishiguro teaches providing a CCD for a film plane, wherein the effective image pickup range of the CCD is such that an image may be captured in either a portrait or landscape orientation; and producing a final image such that the final image is commensurate with the capture image, regardless of whether the captured image is captured on a CCD plane or a film plane. In other words, setting the image effective range in the CCD is directly analogous to setting the effective range in the film plane.

The Applicant further argues that Ishiguro teaches away from the invention because information regarding an image plane size may be transmitted to the camera. However, the mere transmission of the particulars of the CCD to the camera does not teach away from the combination of Fukuda and Ishiguro.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda et al. (U.S. Pat. No. 6,064,834) in view of Ishiguro (U.S. Pat. No. 5,483,284).

Regarding claim 2, Fukuda discloses a camera (Fig. 1, element 10), comprising: an image record member for recording images (Fig. 2, element 120), which are formed within length-direction image pickup effective ranges (Fig. 5, element 68A; Fig. 8) and breadth-direction image pickup effective ranges (Fig. 6, element 68B; Fig. 9) set in film disposed in a main body of said electronic camera, image pickup effective range change member (Fig. 2, element 30) for changing the length-direction image pickup effective ranges and the breadth-direction image pickup effective ranges in the film; wherein said image pickup effective range change member includes a length-direction range change button (Fig. 1, element 28) capable of executing an input operation to

increase the length-direction image pickup effective ranges, and a breadth-direction range change button (Fig. 1, element 28) capable of executing an input operation to increase the breadth-direction image pickup effective ranges; and when said length-direction range change button or said breadth-direction range change button is operated, said image pickup effective range change member (Fig. 1, element 28) changes the length-direction image pickup effective ranges and breadth-direction image pickup effective ranges in such a manner that the area of said image pickup effective ranges in the film is capable to provide a constant value (Figs. 8-9).

Fukuda does not disclose recording images in a solid state image pickup device disposed in a main body of said electronic camera, into a record medium in a form of electronic data. However, Ishiguro discloses a film camera with a replaceable CCD back (Fig. 1). One of ordinary skill in the art at the time of the invention would have provided a film camera like Fukuda's with a replaceable CCD back to enable a camera to capture an image electronically or on film. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to have recorded images in a solid state image pickup device disposed in a main body of said electronic camera, into a record medium in a form of electronic data to provide a photographer with increased flexibility by capturing an image on a variety of media.

Neither Fukuda nor Ishiguro disclose the electronic camera is a digital camera. However, Official Notice is given that it is old and well known in the art to A/D convert the output of a CCD image sensor in order to store the image data as digital data on a removable memory card. As a result, it would have been obvious to one of ordinary skill

in the art at the time of the invention to have configured the electronic camera of Ishiguro as a digital camera to enable a user to upload digital images via a removable memory card to a computer for subsequent image processing.

Regarding claim 3, Fukuda discloses a camera (Fig. 1, element 10), comprising: an image record member for recording images (Fig. 2, element 120), which are formed within length-direction image pickup effective ranges (Fig. 5, element 68A; Fig. 8) and breadth-direction image pickup effective ranges (Fig. 6, element 68B; Fig. 9) set in film disposed in a main body of said electronic camera; and an image pickup effective range change member (Fig. 2, element 30) for changing the length-direction image pickup effective ranges and the breadth-direction image pickup effective ranges in the film, that is, said length-direction image pickup effective ranges and said breadth-direction image pickup effective ranges.

Fukuda does not disclose recording images in a solid state image pickup device disposed in a main body of said electronic camera, into a record medium in a form of electronic data. However, Ishiguro discloses a film camera with a replaceable CCD back (Fig. 1). One of ordinary skill in the art at the time of the invention would have provided a film camera like Fukuda's with a replaceable CCD back to enable a camera to capture an image electronically or on film. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to have recorded images in a solid state image pickup device disposed in a main body of said electronic camera, into a record medium in a form of electronic data to provide a photographer with increased flexibility by capturing an image on a variety of media.

Neither Fukuda nor Ishiguro disclose the electronic camera is a digital camera. However, Official Notice is given that it is old and well known in the art to A/D convert the output of a CCD image sensor in order to store the image data as digital data on a removable memory card. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to have configured the electronic camera of Ishiguro as a digital camera to enable a user to upload digital images via a removable memory card to a computer for subsequent image processing.

Regarding claim 5, Fukuda discloses when there is input a change instruction (Fig. 1, element 28) for said length-direction range change button or said breadth-direction range change button, said image pickup range change member changes the length-direction image pickup effective ranges and the breadth-direction image pickup effective ranges in such a manner that the area of the image pickup effective ranges is capable to provide a constant value (Figs. 8-9).

Allowable Subject Matter

Claims 1, and 4 are allowable or would be allowable if rewritten to overcome any and all objections.

Regarding claim 1, the reason for allowance is as follows: the prior art does not disclose or fairly suggest a digital camera comprising an image pickup effective range setting table having a register of a plurality of records respectively indicating correspondences between the length-direction image pickup effective ranges and the

breadth-direction image pickup effective ranges, wherein said image pickup effective range change member includes a length-direction range change button capable of executing an input operation to increase the length-direction image pickup effective ranges, and a breadth-direction range change button capable of executing an input operation to increase the breadth-direction image pickup effective ranges; and when said length-direction range change button or said breadth-direction range change button is operated, said image pickup effective range change member changes the length-direction image pickup effective ranges and breadth-direction image pickup effective ranges using the image pickup effective range setting table.

Claim 4, is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Jelinek whose telephone number is (571) 272-7366. The examiner can normally be reached on M-F 9:00 am - 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc-Yen Vu can be reached at (571) 272-7320. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian Jelinek
3/29/2006


TUAN HO
PRIMARY EXAMINER